

REMARKS

Claims 22, 23, 25-39, 41-66, 68-83, 85-103, and 105-122 are pending in the Application and all have been rejected in the Office action mailed April 27, 2011. Claims 23, 25-37, 39, 41-57, 59-64, 66, 68-79, 81, 83, 85-101, 103, 105-117, and 119-121 have been amended to correct minor typographical errors. Claims 22, 38, 58, 65, 82, and 102 are independent claims, from which claims 23 and 25-37, claims 39 and 41-57, claims 59-64, claims 66 and 68-81, claims 83 and 85-101, and claims 103 and 105-121 depend, respectively.

The Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is **essential** that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, USPTO personnel should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved. **A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.**

M.P.E.P. §2106(II) (emphasis added).

As such, the Applicants assume, based on the goals of patent examination noted above, that the current Office Action sets forth “all reasons and bases” for rejecting the claims.

As noted above, no claims are substantively amended by this response. Therefore, Applicants respectfully submit that this submission cannot raise new issues that necessitate a new search.

Amendments to the Specification

Applicants have amended the section titled "CROSS REFERENCE TO RELATED APPLICATIONS," to update application status information. Applicants respectfully submit that no new matter is added by these amendments.

Applicants have added new text to the section titled "BRIEF DESCRIPTION OF THE DRAWINGS," briefly describing FIG. 55c. Applicants respectfully submit that no new matter is added.

Applicants have added new text to the section titled "DETAILED DESCRIPTION OF THE INVENTION," describing FIG. 55c. Applicants respectfully submit that no new matter is added.

Amendments to the Drawings

Applicants hereby submit the accompanying new drawing sheet containing FIG. 55c, which illustrates aspects of Applicants' "mobile terminal 5523" of the "hierarchical communication network" of FIG. 55a. Applicants respectfully submit that support for FIG. 55c may be found, for example, at pages 255-263 of the Specification. Applicants respectfully submit that FIG. 55c does not introduce new matter, but merely conforms the drawings to the Specification.

Amendments to Claims

Claims 23, 25-37, 39, 41-57, 59-64, 66, 68-79, 81, 83, 85-101, 103, 105-117, and 119-121 have been amended to correct noted minor typographical errors. Applicants respectfully submit that these amendments do not add new matter, nor do the amendments change the scope of the claimed subject matter.

Rejections of Claims

Claims 102-121 stand rejected under 35 U.S.C. §112, second paragraph. Claims 22, 23, 25-31, 38, 39, 41-50, 61-66, 68-74, 81-83, 85-94, 102, 103, and 105-114 stand rejected under 35 U.S.C. §103(a) as being unpatentable over US 5,737,328, ("Norman") in view of US 5,890,055 ("Chu"), and further in view of US 7,086,008 ("Capps"). Claims 34-36, 53-57, 59, 60, 77-79, 97-101, and 117-121 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Norman in view of Chu, Wadin (US 5,491,739), and Capps. Claims 32, 33, 37, 51, 52, 58, 75, 76, 80, 95, 96, 115, and 116 stand rejected under 35 U.S.C. §103(a) over Norman in view of Chu, US 5,649,108 ("Spiegel"), and Capps. Applicants respectfully traverse the rejections. Applicants respectfully note that all of the claims in the Application are rejected over prior art for alleged reasons of obviousness.

I. Claims 102-121 Are In Compliance With 35 U.S.C. §112, ¶2

Claims 102-121 stand rejected under 35 U.S.C. §112, second paragraph. Applicants respectfully traverse the rejection. Initially, Applicants respectfully note that claim 104, which is included in the claims that were rejected, was previously cancelled.

The Office states, in part, the following at page 2:

2. Claims 102-121 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between necessary structural connections. See MPEP § 2172.01.

Applicants respectfully submit that the only portion of MPEP §2172.01 that relates to a rejection under 35 U.S.C. §112, second paragraph, states the following:

In addition, a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149

(CCPA 1976); In re Collier, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968). >But see Ex parte Nolden, 149 USPQ 378, 380 (Bd. Pat. App. 1965) (“[I]t is not essential to a patentable combination that there be interdependency between the elements of the claimed device or that all the elements operate concurrently toward the desired result”); Ex parte Huber, 148 USPQ 447, 448-49 (Bd. Pat. App. 1965) (A claim does not necessarily fail to comply with 35 U.S.C. 112, second paragraph where the various elements do not function simultaneously, are not directly functionally related, do not directly intercooperate, and/or serve independent purposes.).<

The Office continues the rejection stating, in part, the following at page 3:

3. The omitted structural cooperative relationships are: one circuit for use in communication device where the once [sic] circuit is operational to send, receive, etc.; yet no structural description is given in the specification or claim as how the once (sic) circuit sends, receive etc.
4. Claims 103 — 121 are rejected as being dependent to claim 102.

Applicants respectfully submit that the Office has not identified where in Applicants' Specification Applicants define the “essential elements of the invention” for which the “structural cooperative relationships” have allegedly been omitted.

Notwithstanding the above, Applicants respectfully submit the accompanying new drawing sheet “FIG. 55c,” which shows a high-level block diagram that illustrates circuit elements of “mobile terminal 5523.” Applicants respectfully submit that support for FIG. 55c may be found, for example, at pages 255-263 of the Specification. Applicants respectfully submit that FIG. 55c does not add new matter, but merely conforms the drawings in the Application to the Specification, as described above.

Applicants respectfully submit that the support required under 35 U.S.C. §112, ¶2 for the features of claim 102 may be found, for example, with respect to elements of

FIG. 55a and FIG. 55c, and at page 255 to page 263 of the Specification. Applicants now address the features of claim 102, which is reproduced below, with the portions of Applicants' disclosure that provide the required support for the elements of claim 102 appropriately identified.

At least one circuit for use in a communication device (circuitry of "mobile terminal 5523" of FIG. 55a and FIG. 55c], the at least one circuit operational to, at least:

send, from the communication device to a communication system via a first communication link ("mobile terminal 5523" participates wirelessly as part of "premises network" of FIG. 55a and FIG. 55c and communicates with a "communication system" comprising "access device 5513." See, e.g., page 255, lines 4-7), a first message requesting call routing information identifying call routes for routing of a call from the communication device to a second communication device through a network ("call route request packet" is sent by "mobile terminal 5523" to request a call route through elements of "premises network" to a "telephone line" for establishing a connection to second communication device "telephone 5563." See, e.g., FIG. 55a, page 259, lines 17-20), where the first message comprises information to cause the communication system to send to the communication device the call routes used to select a second communication link ("call route request" sent by "mobile terminal 5523" causes "access device 5513" to communicate with "access device 5509, which records availability of "telephone line 5541" in the "route request" packet, and communicates "route request" to "access device 5505", which sends response ("reply packet") containing information identifying any call routes to a "telephone line" (in this example, "telephone line 5541") for establishing a connection to "telephone 5563." See, e.g., page 259, line 20 to page 60, line 16);

receive, by the communication device from the communication system via the first communication link, a message based upon call routing information received by the communication system over the second communication link ("mobile terminal 5523" receives from "access device 5513" a "reply packet" identifying "telephone line routing pathway" to "telephone line 5541" at "access device 5509," See, e.g., page 260, lines 13-20); and

send, from the communication device to the communication system via the first communication link, a second message requesting setup of the call according to a selected one of the identified call routes, where the second message comprises information to cause the communication system to establish call communication between the communication device and the second communication device using the first communication link and the second communication link ("mobile terminal 5523" wirelessly sends, to "access device 5513" via the "premises network," a "call setup packet" identifying the software or user-selected "call route" through the "communication system" comprising "access device 5513," to establish call communication between "mobile terminal 5523" and "telephone 5563" using a "first communication link" that is the wireless link between "mobile device 5523" and "access device 5513," and a "second communication link" that is the "telephone line 5541." See, e.g., page 260, line 21 to page 261, line 14).

Thus, Applicants respectfully submit that Applicants' disclosure provides a clear example of support for the elements of claim 102 and their structural relationships. Therefore, Applicants believe that claims 102, 103, and 105-121 are in compliance with 35 U.S.C. §112, second paragraph. Applicants respectfully note that claims 103-121 were rejected solely as being dependent from rejected claim 102.

Applicants respectfully note that rejected claims 102, 103, and 105-121 have been of record in the Application since their introduction by preliminary amendment on August 23, 2006, more than five years ago. The subject matter of claims 102, 103, and 105-121 has been examined no fewer than six times, documented in Office actions dated October 16, 2008, May 4, 2009, October 14, 2009, March 31, 2010, August 31, 2010, and April 27, 2011. **At no time prior to the instant Office action has the Office asserted that the language of claim 102 did not meet the requirements of 35 U.S.C. §112, second paragraph. Further, the rejection of claim 102 under 35 U.S.C. §112, second paragraph does not seem to arise from any amendment by the Applicants.**

The Applicants **once again** respectfully note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is **essential** that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, USPTO personnel should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved. **A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.**

M.P.E.P. §2106(II) (emphasis added).

Applicants respectfully submit that the Office is ignoring its own principles of “compact prosecution,” and engaging in piecemeal examination.

For at least the reasons set forth above, Applicants respectfully request that the rejection of pending claims 102, 103, and 105-121 under 35 U.S.C. §112, second paragraph, be reconsidered and withdrawn.

II. The Proposed Combination Of Norman, Chu, And Capps Does Not Render Claims 22, 23, 25-31, 38, 39, 41-50, 61-66, 68-74, 81-83, 85-94, 102, 103, And 105-114 Unpatentable

Claims 22, 23, 25-31, 38, 39, 41-50, 61-66, 68-74, 81-83, 85-94, 102, 103, and 105-114 were rejected under 35 U.S.C. §103(a) as being unpatentable over Norman in view of Chu and Capps. Applicants respectfully traverse the rejection.

Applicants first review the requirements for a rejection based upon obviousness. According to M.P.E.P. §2142, “[t]he examiner bears the initial burden of factually

supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." M.P.E.P. §2142 further states that "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." As recognized in M.P.E.P. §2142, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), 82 USPQ2d 1385, 1396 noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." In addition, the Federal Circuit has made clear that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 127 S. Ct. 1727 (2007), 82 USPQ2d at 1396.

In addition, according to M.P.E.P. §2143.03, "**all words in a claim** must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA)." (emphasis added) The M.P.E.P. also recognizes that "[i]f an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)." *Id.*

Thus, the law is clear that **words of a claim cannot be merely disregarded** during examination. Instead, **all the words in a claim must be considered** during the examination process.

In addition, Applicants respectfully point out that a recent Federal Circuit case clarifies the nature of a *prima facie* case of unpatentability. In particular, *In re Kao* states that the "examiner bears the initial burden of presenting a *prima facie* case of obviousness. See *In re Glaug*, 283 F.3d 1335, 1338 (Fed. Cir. 2002)." *In re Kao*, 2011 U.S. App. LEXIS 9729 (Fed. Cir. May 13, 2011) (attached). Moreover, the Examiner must support conclusions of obviousness with "**substantial evidence**." See *id.* (emphasis added). "Substantial evidence is such relevant evidence as a reasonable mind might accept as adequate to support a conclusion." *In re Kumar*, 418 F.3d 1361,

1366-67 (Fed. Cir. 2005). However, “conjecture does not supply the requisite substantial evidence to support the rejections” See *In re Kao*, 2011 U.S. App. LEXIS 9729 (Fed. Cir. May 13, 2011). Further, conclusory reasoning does not supply the requisite substantial evidence. See *In re Kao*, 2011 U.S. App. LEXIS 9729 (Fed. Cir. May 13, 2011) (“the Board should neither rely upon conclusory reasoning nor its own conjecture in assessing the weight of evidence”).

Further, Applicants respectfully submit that 35 U.S.C. §103(a) recites:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that **the subject matter as a whole** would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

(emphasis added)

In addition, MPEP §2106(II)(A) states, in part:

Finally, when evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, **the claim as a whole must be considered**. See, e.g., *Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981)

(emphasis added)

The M.P.E.P. goes on to state, at §2142, the following:

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether **the claimed invention as a whole** would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983)

(emphasis added)

Applicants respectfully submit that the Office has not established a *prima facie* case that the inventions of each of Applicants' claims, **as a whole**, would have been obvious to one of ordinary skill in the relevant art at the time the inventions were made, for at least the reasons offered during prosecution, and those set forth below.

Initially, Applicants respectfully note that the rejections of independent claims 22, 38, 58, 65, 82, and 102 as set forth in the instant Office action are identical to those of the previous two Office actions. *Compare* March 31, 2010 Office action at pages 3-15 and final Office action of August 31, 2010 at pages 5-16 *with* Office action of April 27, 2011 at pages 3-14. Applicants have previously responded to the repeated arguments of the Office in detail. See July 6, 2010 Response at pages 21-35. Applicant will not repeat the arguments submitted in the July 6, 2010 response again here, but hereby incorporate the response of July 6, 2010 herein, as though set forth in full.

With regard to independent claim 22, Applicants respectfully submit that claim 22 recites "[a] method of operating a communication system, the method comprising: sending, by a first terminal via a communication link, a message requesting routing of a call from the first terminal to a second terminal; receiving, by the first terminal via the communication link, a message comprising call routing information identifying call routes though a network; selecting, at the first terminal, a call route based upon the call routing information, the selecting comprising providing a user of the first terminal with call routing options using the call routing information, and receiving from the user of the first terminal an indication of a selected call route; and transmitting, by the first terminal via the communication link, a message requesting setup of the call from the first terminal to the second terminal using the selected call route." Independent claims 38, 58, 65, 82, and 102 recite similar language. Applicants respectfully submit that the cited art does not teach or suggest all of the features of Applicants' claim 22.

Applicants now present additional reasons why the proposed combination of Norman, Chu, and Capps does not teach, suggest, or disclose all aspects of Applicants' claims.

A. Chu Does Not Remedy The Shortcomings of Norman

The Office admits that "Norman does not disclose a communication link where a message requests routing of a call; selecting a call route; or requesting setup of the call." See April 27, 2011 Office action at page 4. The Office then turns to Chu, citing Chu beginning at col. 4, line 5. The Office action states the following, at page 4:

Chu teaches of requesting routing of a call; selecting a call route; and requesting setup of the call.(4:[0005] read Base station 110 i.e. access point, may be comprised of hardware and software components that perform call setup and switching functions for calls originated from i.e. requesting routing for a call, or destined for wireless end-user devices 10, 11, 12, 14, 50 and 51. The call setup and switching functions i.e. call route, of base station 110 include allocation and administration of radio channels for active wireless end-user devices, tearing down a connection at the end of a call, coordination of call hand-offs from one microcell site to another.)

(emphasis added)

Thus, the Office asserts that the "Base Station 110" of Chu teaches "requesting routing of a call; selecting a call route; and requesting setup of the call." Applicants respectfully note that, according to M.P.E.P. §2143.03, "[a]ll words in a claim **must** be considered in judging the patentability of that claim against the prior art." (emphasis added) This means that recitations of a specific source and destination of a message, or of a call route are material, and cannot be ignored.

Notably, the portion of Chu selected by the Office teaches that the functions provided by cited "Base Station 110" (i.e., "requesting routing of a call;" "selecting a call route;" and "requesting setup of the call") relate to "calls originated from ..., or destined for wireless end-user devices...." Thus, the "Base Station 110" is not considered by Chu to represent, and is distinguished by Chu from, an "end-user device." Applicants'

claim 22 recites, in part, “sending, by a first terminal via a communication link, a message requesting routing of a call from the first terminal to a second terminal,” and that the “user of the first terminal” provides (“...receiving from”) “an indication of a selected call route.” Thus, Applicants respectfully submit that the claimed “first terminal” of Applicants’ claim 22 would be recognized by one of ordinary skill in the relevant art as an “end-user device,” and that the “Base Station 110” of Chu is very different from and does not teach, suggest, or disclose Applicants’ claimed “first terminal,” nor do the purported teachings of Chu regarding “requesting routing of a call; selecting a call route; and requesting setup of the call,” which the Office asserts are performed by the “Base Station 110” of Chu, teach, suggest, or disclose those of an “end-user device.” In other words, Chu teaches that “requesting routing of a call;” “selecting a call route;” and “requesting setup of the call” occur at a “Base Station 110,” which has not been demonstrated by the Office as equivalent to the “first terminal” of Applicants’ claim 22.

Therefore, for at least the reasons set forth above, Applicants respectfully submit that Chu does not remedy the admitted deficiency of Norman. Further, Applicants respectfully submit that the Office does not assert that Capps, or any other prior art, teaches these aspects of claim 22 admittedly missing from Norman. Because the Office has admitted that Norman fails to teach at least these aspects of claim 22, that the Applicants have shown that Chu also does not teach at least these aspects of claim 22, and that the Office has not asserted that any other prior art, including the Capps reference, teaches at least these aspects of claim 22, it then necessarily follows that the proposed combination of Norman, Chu, and Capps cannot, by definition, teach at least these aspects of claim 22. Applicants believe that claim 22 is allowable over the cited art for at least an additional reason.

B. Capps Does Not Remedy The Shortcomings Of Norman And Chu

The Office concedes that "Norman does not provide a user with call routing options using the call routing information; and receiving from the user an indication of a selected call route." *Id.* at page 5. The Office then turns to Capps, stating at page 5, in part:

Chapps [sic] teaches of providing a user with call routing options using the call routing information; and receiving from the user an indication of a selected call route (16: [0046] read Routing options for a note document are accessed i.e. providing a user of the first terminal with call routing options when the user taps a routing action button 372 to display a routing menu 374 listing four routing actions (printing, faxing, beaming, and mailing) together with "duplicate" note and "delete" note actions. Putting the screen interface of FIG. 14 in the context of the process depicted in FIG. 13, one can see that when the user taps button 372 decision step 342 is answered in the affirmative i.e. receiving from the user of the first terminal an indication of a selected call route. Then, the menu listing available routing transactions is displayed as menu 374 in FIG. 14 (in accordance with step 344)..... ..)

As shown above, the Office cites Capps beginning at col. 16, line 46 as disclosing the aspects of claim 22 admittedly missing from Norman. The Office also seemingly recognizes that Chu provides no support for these features of Applicants' claim 22. Applicants have previously addressed the cited portion of Capps. See July 6, 2010 Response at pages 31-33 and November 11, 2010 Pre-Appeal Brief Request for Review at pages 3-4. Applicants now present additional reasons why Capps does not remedy the failings of Norman and Chu.

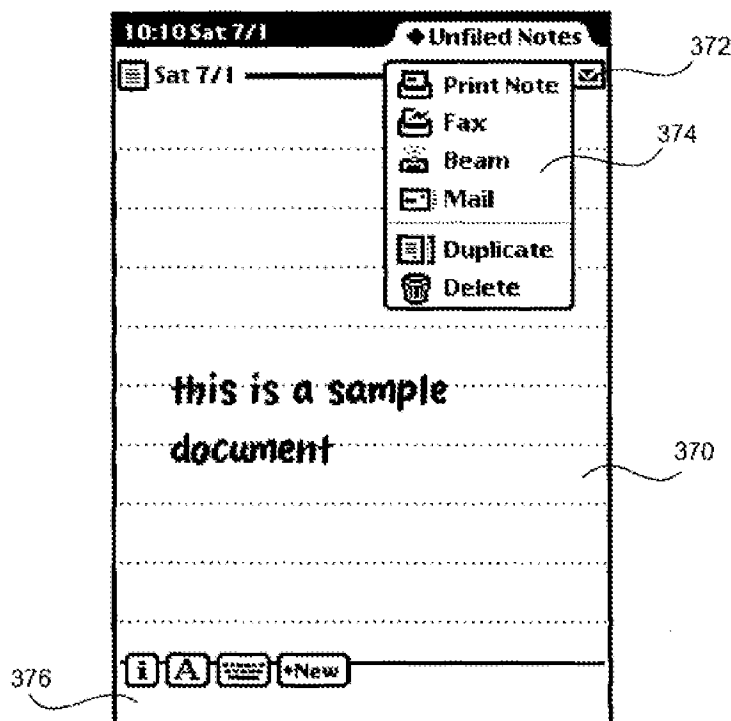
Applicants respectfully submit that Applicants' claim 22 recites, in part, "requesting routing of a call from the first terminal to a second terminal." Claim 22 also recites, in part, "requesting setup of the call from **the** first terminal to **the** second terminal using the **selected call route.**"

Applicants respectfully submit that Capps does not teach “receiving from the user an indication of a selected call route,” in that Applicants’ claimed “selection” is of a “call route” from a “first terminal” to a “second terminal,” not a selection of different destinations or dispositions of a “note document,” as in Capps.

Applicants’ claim 22 recites that Applicants’ claimed “call routing information” identifies “call routes” though a network. Further, claim 22 recites “selecting, at the first terminal, a call route,” “receiving from the user of the first terminal an indication of a selected call route,” and “requesting setup of the call **from the first terminal to the second terminal** using **the selected call route**.”

The word “route” may be defined as “1. a course, way, or road for passage or travel.” See, e.g., <<http://dictionary.reference.com/browse/route>>.

The cited portion of Capps beginning at column 16, line 46, describes a “routing menu 374” as listing various “routing actions” that a user may select. FIG. 14 of Capps, which illustrates the “routing menu 374,” is reproduced below:



Applicants respectfully submit that the selection of each of the “routing actions” of Capps results in a different outcome with a different endpoint. This is so because the “routing actions” of Capps are not choices of “a course, way, or road for passage or travel” of a “call” involving the same first endpoint and second endpoint, nor do they teach or suggest to “request[] setup of the call from the first terminal to the second terminal,” as required by Applicants’ claim 22. Applicants respectfully submit that no two of the selectable items taught by the cited portion of Capps result in the same outcome involving the same “first terminal” and “second terminal,” that is, for example, a “call” from “the first terminal to the second terminal,” as claimed. Instead, one of the choices of “menu 374” causes the “note document” to be sent to a printer, one choice causes the “note document” to be “faxed” somewhere, one choice causes the “note document” to be “beamed” to someone or something, and one choice causes the “note document” to be “mailed.” In other words, Capps does not teach a user selecting the “course, way, or road for passage or travel” of something from a first place to a second place, but instead teaches that what happens to the “note document” of Capps, and where the “note document” ends up after the user selection is made, is different for each selection, which is quite different from, is inconsistent with, and does not teach, suggest, or disclose the aspects of Applicants’ claim 22 admittedly missing from Norman.

Therefore, Applicants respectfully submit that Capps does not remedy the admitted failure of Norman to teach “provid[ing] a user with call routing options using the call routing information; and receiving from the user an indication of a selected call route,” for at least the reasons set forth above. Further, as previously noted, the Office does not assert that Chu provides any support in the rejection of these aspects of claim 22. Because the Office has conceded that Norman does not teach at least these aspects of claim 22, Applicants have demonstrated that Capps does not teach at all of these aspects of claim 22, and the Office does not identify the required support from Chu, it necessarily follows that the proposed combination of references cannot teach or

suggest all aspects of claim 22, and that claim 22 is allowable over the cited art for at least these additional reasons.

Therefore, for at least the reasons set forth above, Applicants respectfully submit that Chu and Capps, taken alone or in combination, do not remedy the admitted shortcomings of Norman, and that the proposed combination of Norman, Chu, and Capps does not teach, suggest, or disclose all aspects of claim 22. Applicants respectfully submit that the Office has therefore not established a *prima facie* case of obviousness with respect to claim 22, as required by M.P.E.P. §2142. Applicants respectfully submit, therefore, that the cited art does not render claim 22 unpatentable for at least the reasons set forth above, and that claim 22, and any claims that depend therefrom, are allowable for at least this additional reasons.

With regard to independent claim 65, Applicants respectfully submit that claim 65 was rejected for the same reasons citing the same art used in the rejection of claim 22, and that claim 65, and therefore any claims that depend therefrom, are allowable for at least some of the reasons set forth above.

With regard to independent claims 38, 82, and 102, Applicants respectfully submit that claims 38, 82, and 102 recite features similar to those of claims 22 and 65, that claims 38, 82, and 102 are rejected for the same reasons over the same art used in rejecting claims 22 and 65, and that claims 38, 82, and 102 are allowable over the cited art for at least some of the reasons set forth above with respect to claims 22 and 65. Further, claims 39 and 41-57, claims 83 and 85-101, and claims 103 and 105-121 that depend from allowable claims 38, 82, and 102 are also allowable over the cited art, for at least the same reasons.

Accordingly, Applicants respectfully request that the rejections of claims 22, 23, 25-31, 38, 39, 41-50, 61-66, 68-74, 81-83, 85-94, 102, 103, and 105-114 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

III. The Proposed Combination Of Norman, Chu, Spiegel, And Capps Does Not Render Claims 32, 33, 37, 51, 52, 58, 75, 76, 80, 95, 96, 115, And 116 Unpatentable

Claims 32, 33, 37, 51, 52, 58, 75, 76, 80, 95, 96, 115, and 116 were rejected under 35 U.S.C. §103(a) over Norman in view of Chu, Spiegel, and Capps. Applicants respectfully traverse the rejection.

With regard to independent claim 58, Applicants respectfully submit that claim 58 recites limitations similar to those of claims 22, 38, 65, 82, and 102, that the rejection of claim 58 does not specifically address all of the features of claim 58, that claim 58 recites features similar to those of claims 22, 38, 65, 82, and 102, and that all of independent claims 22, 38, 58, 65, 82, and 102 are rejected based upon a combination of references that includes Norman, Chu, and Capps. Applicants have shown above that claims 22, 38, 65, 82, and 102 are allowable over the proposed combination of Norman, Chu, and Capps. Applicants respectfully submit that claim 58 is also allowable over the proposed combination of references, in that the Office fails to assert that Spiegel remedies any of the shortcomings of Norman, Chu, and Capps set forth above with respect to the features of claims 22, 38, 65, 82, and 102 shared by claim 58. For at least these reasons, Applicants respectfully submit that claim 58, and therefore claims 59-64 that depend from claim 58, are allowable over the cited art. Accordingly, Applicants respectfully request that the rejection of claim 58 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

IV. The Proposed Combination Of Norman, Chu, Wadin, And Capps Does Not Render Claims 34-36, 53-57, 59, 60, 77-79, 97-101, And 117-121 Unpatentable

Claims 34-36, 53-57, 59, 60, 77-79, 97-101, and 117-121 were rejected under 35 U.S.C. §103(a) as being unpatentable over Norman in view of Chu, Wadin, and Capps. Applicants respectfully traverse the rejection. Applicants respectfully submit that claims 34-36, claims 53-57, claims 59 and 60, claims 77-79, claims 97-101, and claims 117-121 depend, directly or indirectly, from independent claims 22, 38, 58, 65, 82, and 102.

Applicants respectfully submit that independent claims 22, 38, 65, 82, and 102 are allowable over the proposed combination of references in that the Office has not

asserted that Wadin remedies the deficiencies of Norman, Chu, and Capps set forth above. Because claims 22, 38, 65, 82, and 102 are allowable over the proposed combination of references, Applicants respectfully submit that claims 34-36, claims 53-57, claims 77-79, claims 97-101, and claims 117-121 that depend from claims 22, 38, 65, 82, and 102 are also allowable over the cited art, for at least the same reasons.

Applicants respectfully submit that independent claim 58 is allowable over the combination of Norman, Chu, Spiegel, Capps, and Wadin in that the Office has not asserted that Wadin overcomes the shortcomings of Norman, Chu, Spiegel, and Capps, set forth above. Because claims 59 and 60 depend from allowable claim 58, Applicants respectfully submit that claims 59 and 60 are also allowable over Norman, Chu, Spiegel, Capps, and Wadin for at least the reasons set forth above.

Based at least upon the above, Applicants respectfully submit that claims 34-36, 53-57, 59, 60, 77-79, 97-101, and 117-121 are allowable over the respective cited art, and respectfully request that the rejection of claims 34-36, 53-57, 59, 60, 77-79, 97-101, and 117-121 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

V. Obviousness Guidelines

Additionally, referring to the PTO's published guidelines of October 10, 2007, with regard to the procedure to be followed by Examiners when making an obviousness rejection, the guidelines recite **seven rationales** supporting an obviousness rejection and give specific findings that **must be made** by an Examiner in order for the Examiner to use the rationale to support a finding of obviousness. These findings are **not optional and must be articulated by the Examiner for the rationale to apply**. The seven rationales are shown below.

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;

(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

If the present rejection is maintained, or any new rejection based on obviousness is asserted, however, the Applicant respectfully requests that any subsequent action: 1) **identify the specific Rationale** (i.e., by explicitly indentifying one of **A through G** noted above) in the Guidelines that the Examiner is using to support the obviousness rejection so that the Applicants may more clearly address the Examiner’s concerns, and 2) **state on the record** the **required** factual findings to support the Rationale that the Examiner has chosen.

As indicated recently, “[i]t is important for Office personnel to recognize that when they do choose to formulate an obviousness rejection using one of the rationales suggested by the Supreme Court in *KSR* and discussed in the *2007 KSR Guidelines*, they are to adhere to the instructions provided in the MPEP regarding the **necessary factual findings**.” See September 1, 2010 Examination Guidelines Update, 75 Fed. Reg. 169.

Indeed, “if a rejection has been made that omits one of the required factual findings, and in response to the rejection a practitioner or inventor points out the

omission, Office personnel **must** either withdraw the rejection, or repeat the rejection **including all the required factual findings.**” *See id.*

Further, “[s]imply stating the principle ... without providing an explanation of its applicability to the facts of the case at hand is generally not sufficient to establish a *prima facie* case of obviousness.” *See id.*

“[T]he Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.” *See In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

Thus, as indicated above, the Applicants respectfully request that any subsequent Office Action that asserts an obviousness rejection **specifically identify** which rationale it is using, and then provide **the required factual findings** with respect to the rationale.

Conclusion

In general, the Office Action makes various statements regarding the claims and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, the Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicants believe that all of pending claims 22, 23, 25-39, 41-66, 68-83, 85-103, and 105-121 are in condition for allowance. Therefore, allowance of claims 22, 23, 25-39, 41-66, 68-83, 85-103, and 105-121 is respectfully requested.

The Commissioner is hereby authorized to charge any fees required by this submission, or to credit any overpayments, to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Should the Examiner disagree or have any questions regarding this submission, the Applicants invite the Examiner to telephone the undersigned at (312) 775-8000 to resolve any issues.

Respectfully submitted,

Dated: August 27, 2011
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